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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

HEWITT II, CALVIN L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3621

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/754,465

Applicant(s)

GRAY ET AL.

Examiner

Calvin L Hewitt II

Art Unit

3621

NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Status of Claims

1. Claims 1-38 have been examined.

Response to Arguments/Amendments

2. The Examiner maintains the 112 first rejection to claims 1-5 and 12-26.
Claim 1 reads “forms comprising an authorization by said security processor of said input to said security processor”. An electronic form is a data structure. To one of ordinary skill, “ a form comprising an authorization” is interpreted as a form with entry or value indicative of security processor authorization such as a digital signature or time stamp.

The prior art of Daly et al. clearly teaches the Applicant's method, in particular, limitations 1e-g. According to Daly et al. a user initiates a transaction by communicating with a security server (column 7, lines 1-10). The server then evaluates the transaction and if authenticated presents the user with a list of payment options (column 7, lines 25-65). The user's selection of a payment method is a request for second authorization, as the security server will then check the value of the transaction against the user's credit limit (column 7, lines 37-46; column 13, lines 22-34). In the Applicant's method, the “forms” are passive in that they are not sent nor received. Note, only the request is “sent”. Therefore, figure 5 (Daly et al.) is a valid teaching of the Applicant's “forms” as it

inherently comprises authorization from the server evidenced by the presentation of available payment methods to a user (figure 5, item 110) and it is provided, processed and associated with the transaction.

The Examiner maintains the rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-5, and 12-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1, 12, 17, and 22 recite "said forms comprising said security processor authorization". To one of ordinary skill this means the authorization is present in the form. This feature is not supported by the Specification (Specification, page 10, lines 25-30; page 11, lines 5-9 and 16-28).

Claims 2-5, 13-16, 18-21 and 23-26 are also rejected as they depend from claims 1, 12, 17 and 22 are also rejected as they depend from claims 1, 12, 17 and 22 respectively.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5, 12-26, and 27-38 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Daly et al., U.S. Patent No. 5,878,141.

As per claims 1-5 and 12-26 Daly et al. teach a method for conducting electronic transactions (figure 1) comprising:

- an authentication server receiving a request to authenticate a transaction from a user at a server (figure 6)
- requiring the user to provide an instrument (e.g. smart card) for verification, receiving an instrument input in response, processing

said instrument input as input to a security processor (figure 1;
column 5, lines 45-55; column 6, lines 36-55; column/line 8/62-9/7)

- assembling forms for the transaction, said forms comprising said security processor authorization of said input to said security processor (figure 5)
- authorizing the forms twice at a security processor (column 7, lines 5-17; column 8, lines 20-61)
- validating the transaction with the second authorization (column 8, lines 47-61)
- providing transaction validation for different combinations of instruments and security processors without requiring changes to transaction processing by said merchant (figure 1)
- a digital wallet (column/line 2/64-3/6; column 8, lines 12-20)

As per claims 27-38, Daly teaches a transaction system operative to provide validation for different combinations of instruments and processors (figure 1; column 7, lines 48-63; column/line 8/62-9/7) comprising:

- a data network, including an instrument and operative to permit initiation of a transaction (figure 1)

- an authorization server (e.g. electronic purchase server) coupled to receive said initiation as input and transmit same to a security server (column 7, lines 8-17)
- a security server receives the data from the authorization server and generates and transmits an authorization form to said authorization server, and an interface coupled to the security server and operative to permit validation of said form and complete a secure online virtual transaction (column 8, lines 47-61)
- an electronic purchase server coupled to a digital wallet and operative to validate transaction input transmitted to said security server

7. Claims 6 and 8-11 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Gifford, U.S. Patent No. 6,049,785.

As per claims 6 and 8-11, Gifford teaches a method for performing electronic transactions comprising: developing a first query for transmission to a credit provider, selected from a group of credit providers, receiving a response from said credit provider and transmitting same to said merchant, said merchant querying said credit provider for authentication of said credit provider for authentication of said credit provider response; and completing said virtual transaction using authorization from said credit provider (figure 12; column 7, lines 55-61). Gifford also teaches developing a form from a response from a

credit provider and sending the form to a merchant (figure 12), requesting authentication of the form from the credit provider (column 7, lines 55-61).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gifford, U.S. Patent No. 6,049,785.

As per claim 7, Gifford teaches the use of smart card (column/line 10/51-11/3). Therefore, it would have been obvious to open a wallet and input a smart card in order to authenticate a transaction (column 10, lines 23-26).

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is

filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

Art Unit: 3621

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Calvin Loyd Hewitt II

May 27, 2004



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600